

REMARKS

The Office Action

Claims 1-37 are pending and stand rejected for lack of enablement and indefiniteness.

Support for the Amendments

Claims 1, 2, 3, 4, and 5 have been amended for clarity. No new matter has been added.

Rejections under 35 U.S.C. § 112, first paragraph

The Office has rejected all claims for lack of enablement because, in its view, “[t]he processing conditions as noted in Tables I-IV are critical or essential to the practice of the invention, but not included in the claim(s).” Applicants traverse this rejection.

35 U.S.C. § 112, first paragraph requires that a “disclosure, when filed, contain sufficient information regarding the subject matter of the claims as to enable one skilled in the pertinent art to make and use the claimed invention” without undue experimentation (M.P.E.P. § 2164). The application as filed meets this standard.

The rejection is based on Applicants’ arguments to distinguish the present claims over the Garner reference. In the previous Reply and Request for Pre-Appeal Brief Conference, Applicants argued that Garner did not inherently disclose the subject matter of the present claims because the conditions of an extraction determine what constituents,

if any, are extracted. By making these arguments to distinguish the present claims from Garner, Applicants, however, did not imply that the conditions listed in Tables I-IV are the sole conditions necessary to practice the invention. Indeed, variations of these parameters will still produce the claimed effects.

Moreover, although Applicants affirm their previous position that merely contacting tobacco with a subcritical fluid, as taught by Garner, is insufficient to achieve the claimed results, Applicants disagree with the Office's interpretation of the present claims. Prior to the present amendment, each of the independent claims recited a phrase such as "wherein said amount of said constituent dissolves in said subcritical fluid." Each of the claimed methods therefore is not directed to the mere contact of a subcritical fluid with tobacco, but instead each claim required a particular result, implying that the contact must occur under appropriate conditions. In deference to the Office's concern, however, Applicants have reworded this phrase in each of the claims to recite, for example, "under conditions so that said amount of said constituent dissolves in said subcritical fluid." Accordingly, the claims now explicitly refer to the conditions necessary to produce the claimed effect. Furthermore, the specification provides ample guidance to the skilled artisan for determining such conditions, e.g., Examples 1-5. The rejection may be withdrawn.

Rejections under 35 U.S.C. § 112, second paragraph

Claims 1-37 also stand rejected for indefiniteness for failure “to particularly point out and claim the subject matter which applicant regards as the invention.” Specifically, the Office states: “If the above noted process parameters are deemed as necessary to achieve the claimed effect as implied by applicant, it is unclear in reciting the claimed effect, to which distinct and particular process parameter is applicant seeking patent protection.” Applicants traverse this rejection.

The basis for this rejection appears to be identical to that of the enablement rejection, and as discussed above, the amended claims refer to the conditions achieving the claimed result. For the record, Applicants seek patent protection for all process parameters that result in the claimed effect. This rejection may also be withdrawn.

Information Disclosure Statement

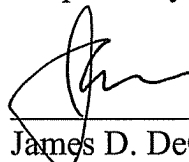
Applicants note that the Form PTO 1449 that was submitted with an Information Disclosure Statement filed on February 23, 2006 has not been initialed and returned, and hereby request that it be initialed and returned with the next Office action.

CONCLUSION

Applicants submit that the claims are in condition for allowance, and such action is respectfully requested. If there are any charges or any credits, please apply them to Deposit Account No. 03-2095.

Respectfully submitted,

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James D. DeCamp, Ph.D.
Reg. No. 43,580

Clark & Elbing LLP
101 Federal Street
Boston, MA 02110
Telephone: 617-428-0200
Facsimile: 617-428-7045